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Frank Niebuhr

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EXAMINER

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* FRANK NIEBUHR, MATTHIAS LUDWIG,  
SVEN HARDEL, JOACHIM BEBENROTH-STRUSS,  
HANS-JOACHIM LANGHOFF, TOBIAS NIESNER,  
HARALD BATKE, SOREN BENEKE, and MARCUS LUTZ

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Appeal 2008-4173  
Application 10/849,618  
Technology Center 1700

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Decided: September 18, 2008

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Before PETER F. KRATZ, JEFFREY T. SMITH, and  
LINDA M. GAUDETTE, *Administrative Patent Judges*.

KRATZ, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 from the Examiner's final rejection of claims 1-13, 22, and 23. We have jurisdiction pursuant to 35 U.S.C. § 6.

Appellants' claimed invention is directed to a method of manufacturing a composite part having an outer skin useful as part of a vehicle wherein the outer skin could be visibly exposed in the installed state (Spec. ¶¶ 0007-0008). In the method, a foil part has a removable protective foil located on an outer skin front side. The method includes reworking the removable protective foil so as to smooth a surface on the outer side thereof prior to placing the foil part together with the removable protective foil in a die. The claimed method is illustrated by claim 1, which is reproduced below:

1. A method for manufacturing a composite part having an outer skin that is visible when the composite part is installed in a vehicle, comprising:

- (a) providing a foil part having the outer skin, the foil part having a removable protective foil disposed on a front side of the outer skin, the removable protective foil having an outer side;
- (b) reworking the removable protective foil to smooth a surface of the outer side;
- (c) placing the foil part together with the removable protective foil in a die subsequent to step (b); and
- (d) applying a plastic layer via a high-pressure process on a rear side of the outer skin.

In addition to allegedly admitted prior art, the Examiner relies on the following prior art reference as evidence in rejecting the appealed claims:

Gossie	3,970,508	July 20, 1976
Yamazaki	5,989,480	Nov. 23, 1999

Specification [0006] Admitted prior art (APA)

Claims 1-11, and 13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over alleged admitted prior art (APA) set forth in paragraph 0006 of the Specification in view of Yamazaki. Claims 12 and 23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over APA in view of Yamazaki and Gossie.

We reverse the stated rejections for reasons set forth in Appellants' Brief, as further discussed below.

#### Rejection over APA in view of Yamazaki

The applied APA provides that:

In one prior method for manufacturing a composite part, a foil that has yet to be back-foamed (hereinafter termed "foil part") is delivered to a part manufacturer with a protective foil on its exterior side. Due to the protective foil, the exterior side of the foil part, which will later be visible on the completed composite part, is not damaged during shipment.

The component part that will be finished later is also delivered to an automobile manufacturer with the protective foil on it.

The protective foil is removed just before assembling the composite part onto the vehicle in order to avoid damage or contamination.

#### Spec. ¶ 0006

The Examiner acknowledges that the APA does not disclose reworking a removable protective foil to smooth an outer surface thereof, much less teach such a reworking prior to placement in a die, as is required by all of the appealed claims. See, for example, the sole independent claim on appeal, namely claim 1. The Examiner turns to Yamazaki.

Yamazaki discloses a method of molding a patterned product, including interior and exterior parts of automobiles wherein an insert film

carries a decoration pattern thereon, which pattern applies decorative features to a product simultaneously with injection molding of the product. The insert layer is bound to the molded product via a bonding layer (Yamazaki, col. 5, l. 60 – col. 6, l. 19). As pointed out by the Examiner, Yamazaki teaches that “the film is never held in touch with a fixed mold while the film is wrinkled or twisted” (Ans. 3; Yamazaki, col. 14, ll. 62-63). Based on this teaching of Yamazaki coupled with the APA, the Examiner asserts that “it would have been obvious to one of ordinary skill in the art to rework the foil or foils of the admitted prior art process to smooth its surface before establishing its position within a die or mold in order to prevent the foil from contacting the mold while it is wrinkled” (Ans. 4).

Appellants maintain that the film of Yamazaki is not a removable protective foil but rather a patterned decorative layer that forms part of the mold product part. Moreover, Appellants contend that Yamazaki does not teach reworking of such a removable protective foil before such a protective foil together with a foil part are placed in a die, as required by the appealed claims. In this regard, Appellants note that the tension applied or impressed to the insert film of Yamazaki relates to a positioning step of the insert film in a mold and not a reworking step of a removable protective foil according to the appealed claims, which step occurs prior to placing such a removable protective foil together with a foil part in a die (Br.4-5).

On this record, Appellants bring forth the more persuasive arguments. In this regard, the burden of establishing a prima facie case of non-patentability resides with the Patent and Trademark Office (PTO). *See In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984).

Here, the APA is the only applied evidence that employs a removable protective foil with the furnished discussion respecting such admitted prior art removable protective foil centering on the protective function thereof during shipping. The APA does not specifically mention what role, if any the removable protective foil may play during a “back-foaming” part manufacture operation. Nor does the APA identify any problems with respect to a back-foaming part manufacturing operation or with regard to any possible unwanted twisting or wrinkling being associated with a foil part having a removable protective film placed on an exterior side thereof. Yamazaki is not directed to placing such a foil part having a removable protective foil on an outer side thereof in a die. Hence, we agree with Appellants that the Examiner has not established that recognition of a problem together with an obvious solution thereto was presented by these prior art teachings such that one of ordinary skill in the art would have been led to Appellants’ claimed method. The analysis supporting obviousness should “identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements” in the manner claimed. *KSR Int’l Co. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007).

It follows that, on this record, we are constrained to reverse the Examiner’s obviousness rejection over the APA in view of Yamazaki.  
Rejection over APA in view of Yamazaki and Gossie

Since the Examiner’s subsequent rejection of dependent claims 12 and 23 rely, at least in part, on the Examiner’s application of the APA and Yamazaki and the Examiner has not fairly articulated how Gossie fills the void in the combination of the APA and Yamazaki as discussed above, the

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rejection of these latter claims fails for the same reasons. Accordingly, we cannot sustain the Examiner's rejections of any of the claims.

### CONCLUSION

The decision of the Examiner to reject claims 1-11, and 13 under 35 U.S.C. § 103(a) as being unpatentable over the APA in view of Yamazaki; and to reject claims 12 and 23 under 35 U.S.C. § 103(a) as being unpatentable over the APA in view of Yamazaki and Gossie is reversed.

REVERSED

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